

Remarks and Arguments

Claims 1-3, 6-19, 22-35, 38, 40-45 and 48-52 have been presented for examination. Claims 1, 17, 33 and 48 have been amended. New claims 53-56 have been added.

This office communication sets forth, as admitted prior art, selected content which the office communication claims was “officially noticed” in prior office communications. Presumably, these “official notices” refer to the official notice taken in the office communication dated November 2, 2004. There, official notice was taken twice: “official notice” was taken that a traditional call center as taught by U.S. Patent No. 5,884,032 was old and well-known in the arts of customer relationship management, help desk, customer service and support and telemarketing. Further “official notice” was taken that performing a query on a database and generating a report from the query is old and very well known in the use of databases. However, the remainder of the statements now contended to be “admitted prior art” appears to be examiner argument or an attempted examiner characterization of the “officially noticed” content. Therefore, applicant disputes that, other than the subjects of “official notices” set forth in the office communication dated November 2, 2004, that the remainder of the statements set forth on paragraph three of this office action constitute applicant admitted prior art.

Claims 1, 17, 27, 33 and 48 have been objected to because the claims recite a method and apparatus for managing workplace services and further recite that a specialist “can” provide assistance, but do not recite that the specialist actually “provides” the assistance. In response, the claims have been amended to positively recite that the specialist provides the assistance. For example, claim 1 has been amended to recite, in lines 19-25, “...providing from the workplace resources office to that user, contact information which allows that user to immediately and directly contact a specialist with expertise specific to their unique workplace issues and who is not one of the workplace resources office personnel in order to establish a communication session during which the specialist **provides** assistance on a specific workplace issue to that user...(emphasis added)” Thus, claim 1 clearly states that the specialist provides assistance. Claims 17, 33 and 48 have been amended in a similar fashion.

Claim 27 has also been amended to recite “a web interface connecting the specialist to the database via the Internet so that the specialist **obtains** the user identifying information verbally from the user, **enters** the user identifying information into the database via a web interface and **receives** the user background information via a web browser.” Consequently, claim 27 also positively recites the specialist actions.

Claims 1-3, 6-19, 22-35, 38, 40-45 and 48-52 have been rejected under 35 U.S.C. §103(a) as obvious over Ernst & Young’s Online Business Consulting System called “Ernie” as disclosed in the cited Litwin, Baum and Weiss articles (hereinafter collectively designated as “Ernie”).

As previously discussed, the present invention provides workplace services and products to an organization by a three part system comprising workplace resource office personnel who gather background information, a knowledge management database that is populated before users contact the specialists and specialist(s) that answer specific questions based on information from the knowledge management database. One of the goals of this system is to establish, as soon as possible, a direct relationship between a user who has a specific question for which an answer is required and a specialist who has specific expertise in the appropriate area in order to provide an answer. To this end the workplace resource office personnel who gather the background information, use this information and information provided by the users to select a specialist. They then provide contact information, such as a telephone number or a web address, to the user before any questions arise. This information enables that user to immediately and directly contact the specialist when a specific question based on a situation that is unique to a user arises. This arrangement allows the user to bypass the usual call center, automated directory or FAQ processes of the prior art. The direct user-specialist relationship is important in many areas, such as where legal advice is given in order to preserve the attorney-client privilege attendant to the answers given by an attorney.

The Ernie system retains an indirect communication path between the user and the specialist. In the Ernie system, the consulting organization contacts potential users on a purely marketing level, that is, to sell the online services to the users. However, no attempt is made to determine any background information which would allow the organization to pre-select a specialist. Instead, when a user has a specific question a

specific process is followed. Of particular interest is Exhibit 3 entitled "Process Flow of Incoming Questions" attached to the Litwin article (Reference A, page 20). In accordance with this process, the user is directed first to consult an on-line database on the chance that it might contain a general answer to the user's question. If the user has a specific question they are then referred to a "Focal Knowledge Provider" (FKP) who is not a specialist who provides answers, but a person who is knowledgeable in the general area. The FKP then directs the question to an actual specialist who provides the answer. This latter process is stated to take up to two business days (See also the article by John Makulowith in the Washington Technology magazine v. 11 n. 17, first page, first paragraph to second page, second paragraph (Reference A, page 13, first paragraph to page 14, second paragraph.)

The differences between these two systems are recited in the claims. Claim 1 is illustrative. It recites in step (a) (lines 5-8) that, upon a request from an organization to which users belong, workplace resources office personnel contact the users to obtain background information. The examiner indicates the Ernie literature discloses that, upon a request from an organization to which users belong, that customized workplace services and information are made available. As discussed above, all initial contacts in the Ernie system are sales contacts; no initial information gathering contacts are made.

The examiner analogizes the disclosed FKP to the workplace resources office personnel who gather background information. However, it is clear, as discussed above, that the FKP becomes involved after a user has a specific question rather than before. As claimed in claim 1, steps (c) and (d) the workplace resource office personnel store back ground information collected in step (a) in a database before a user contacts a specialist (lines 13-15) and then, before one of the plurality of users attempts to obtain specific assistance with any issue unique to their workplace and based on the background information, the workplace resources office personnel providing from the workplace resources office to that user, contact information which allows that user to immediately and directly contact a specialist (lines 17-20). Thus, the proposed analogy is not correct. (The examiner notes that "Ernie **staffers** help users to formulate their initial questions. In the current invention, it is the **specialist** who helps them formulate their questions based on the background information that the specialist retrieves from

the database and any additional information, corrections or updates provided by the user to the specialist during the communication session; instant specification, page 12, line 27 to page 13, line 2. Further, the use of a staffer in an attorney/client relationship would destroy the attorney-client privilege.)

The Ernie system reaches away from the claimed invention and therefore cannot suggest it. The claimed invention teaches that a direct user/specialist relationship is of paramount importance. The Ernie system is designed to generate a database that evolves so that users become less dependent on human interaction, Reference A, page 6, second column, third paragraph. Further, it is noted that the creators of Ernie were aware of the problem solved by the invention, but did not arrive at the claimed solution. In particular, the initial incarnation of Ernie involved users sending questions directly to Ernie. However, it was decided that this required the users to input a cumbersome amount of information to ensure that the question was delivered to the correct expert. Therefore, Ernie was changed so that the questions were sent to a clearinghouse and then routed to the appropriate specialist. Reference A, page 12, column 1, paragraph 5. Consequently, the Ernie literature cannot suggest the claimed invention.

The examiner acknowledges that the Ernie references do not teach using the workplace resources personnel to initially contact the plurality of users in order to obtain user and background information as claimed. However, the examiner contends that the identity of the people who contact the users constitutes "descriptive material" that is not functionally involved with the recited steps and does not alter the recited structural elements. The examiner further claims that the recited steps and functional elements would be exactly the same regardless of who collects the information. Thus, the examiner concludes that the recitation of the workplace personnel cannot distinguish the claims from the recited prior art.

Applicant respectfully disagrees. While the name of the people who collect the information is not important, their identity, the order in which the method steps are performed and the way that the structural elements interact is important and distinguishes the invention from the cited prior art. For example, the workplace resources personnel cannot be the specialists as recited in claim 1, lines 6-7. Otherwise the system devolves into a standard client/professional relationship which is

not cost effective and does not lead to the cost savings discussed in the oral presentation made to the examiner on August 8, 2005. Further, the workplace resources office personnel must contact the users, obtain the background information and provide information that allows the users to directly contact the specialists before a specific question arises (see claim 1, lines 12-20). Thus, claim 1 contains positive limitations that are not met by the cited prior art.

The *In re Gulack* and *In re Lowry* decisions cited by the examiner are inapposite. *In re Gulack* concerns “printed matter” rejections and the functional relationship of the printed matter and the substrate on which the printed matter is printed. There is no analogy between the printed matter and the substrates discussed in the *Gulack* decision and methods and systems claimed in the instant application and the examiner has not pointed out such an analogy. It is noted that the *Gulack* decision itself cautions against the use of “printed matter rejections” under section 103, *In re Gulack* 703 F. 2d at 1385 n. 8. The *In re Lowry* decision, which refers to the *In re Gulack* decision, concerns data structures existing in a computer memory. The examiner has not indicated any analogy to such structures. It is noted that the examiner must establish a *prima facie* case of obviousness *In re Oetiker*, 977 F. 2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). As discussed above the Ernie literature does not disclose or suggest the specific limitations and method step order defined in the present claims. Thus, the examiner has not established a *prima facie* case of obviousness and claim 1 patentably distinguishes over the system disclosed in the cited literature.

Claims 2-16 are dependent upon, either directly or indirectly, on amended claim 1 and incorporate the limitations thereof. Therefore, they also distinguish over the cited references in the same manner as amended claim 1. These claims also recite further limitations not taught or suggested by the Ernie literature. For example, claims 8 and 10 recite details concerning how a personal ID code is assigned to each of the users. The examiner takes official notice that there exists a plurality of well-known methods for assigning identifiers to users. However, it is noted that claim 8 depends on claim 7 and ultimately on claim 1 and that the user identifying information is entered into a database which is created prior contact between a user and a specialist as indicated in claim 1,

step (c). If the examiner is implying that the timing and other limitations set forth in claim 1 are well-known, then he is requested to provide references detailing that fact.

Similarly, claim 10 is dependent on claims 9 and 1 and further limits method step (b) and, consequently, again, the user identifying information is entered into a database which is created prior contact between a user and a specialist as indicated in claim 1, step (c). Therefore, if the examiner is implying that the timing and other limitations set forth in claim 1 are well-known, then he is requested to provide references detailing that fact. The examiner further indicates that the identity of the entity that assigns the user identifier is descriptive matter and, accordingly, is non-limiting, citing the *In re Gulack* and *In re Lowry* cases. These cases are discussed above and that discussion is referenced here.

Claim 11 further indicates that the specialist obtains the user identifying information verbally from the user, enters the user identifying information into the database via a web interface and receives the user background information via a web browser. The examiner takes official notice that obtaining user identifying information verbally is well-known, citing call centers and credit card companies. However, it is noted that none of the examples cited by the examiner involve a user directly interacting with a specialist. Further, it is noted that in the Ernie system, the specialist cannot verbally receive information from the user, since the specialist and user have no direct relationship or contact - the direct contact is between the user and FKP. Consequently, if the examiner is implying that using a specialist to receive this information is well-known, then he is requested to provide supporting references. The examiner further claims that the identity of the person who receives the information is descriptive matter and, accordingly, is non-limiting, citing the *In re Gulack* and *In re Lowry* cases. These cases are discussed above and that discussion is referenced here.

Claim 12 further indicates that the specialist assigns communication session information to a predefined category. The examiner admits that the Ernie system does not teach this (in Ernie, the FKP, a staffer, categorizes the calls), but takes official notice that categorizing calls is well-known. However, it is noted that none of the examples cited by the examiner involve a user directly interacting with a specialist. Further, it is noted that in the Ernie system, the specialist cannot verbally receive information from

the user, since the specialist and user have no direct relationship or contact; the direct contact is between the user and FKP. Consequently, if the examiner is implying that using a specialist to receive this information is well-known, then he is requested to provide supporting references.

The examiner further claims that the identity of the person who categorizes the communication session information is descriptive matter and, accordingly, is non-limiting, citing the *In re Gulack* and *In re Lowry* cases. These cases are discussed above and that discussion is referenced here. In addition, the applicant respectfully disagrees that the identity of the person who categorizes calls is merely descriptive, since the specialist, who has heard the user describe the problem, has expertise in the area and actually provides assistance is clearly the best person to decide how that assistance should be categorized.

Claims 17, 33 and 48 have been amended in the same manner as amended claim 1. Consequently, these claims distinguish over the references in the same manner as amended claim 1. Claims 18-32 are dependent upon, either directly or indirectly, on amended claim 17 and incorporate the limitations thereof. Therefore, they also distinguish over the cited references in the same manner as amended claim 17. In addition these claims, parallel claims 2-16 and distinguish over the cited references in the same manner as those claims as discussed above.

Claims 34-38 are dependent upon, either directly or indirectly, on amended claim 33 and incorporate the limitations thereof. Therefore, they also distinguish over the cited references in the same manner as amended claim 33. In addition these claims, parallel claims 2-16 and distinguish over the cited references in the same manner as those claims.

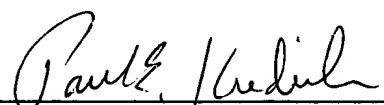
Claims 49-52 are dependent on amended claim 48 and incorporate the limitations thereof. Therefore, they also distinguish over the cited references in the same manner as amended claim 48. In addition, these claims further recite that an insurer contracts with the workplace resources office and the organization is an insured of the insurer (49) and that the legal experts are associated with the workplace resources office (50) and the contact people are employees of the organization (51). The examiner asserts that the Ernie literature discloses that the Ernie system is

applicable to many industries. However, other than disclosing that Ernie is a breakthrough in electronic commerce and a powerful trend, all of the discussion focuses on the use of Ernie in an accounting and tax environment. Nothing is mentioned concerning the insurance industry. Further, as discussed above, the Ernie system does not have an equivalent to the recited workplace resources office and, thus, the contract between the insurer and the workplace resources office and the location of the legal experts cannot be taught or suggested by the Ernie literature. The examiner further claims that recitation that an insurer contracts with the workplace resources office and that the organization is the insured is descriptive matter and, accordingly, is non-limiting, citing the *In re Gulack* and *In re Lowry* cases. These cases are discussed above and that discussion is referenced here. Consequently, claims 49-52 patentably distinguish over the cited literature references.

New claims 53-56 have been added to cover the "closed-loop" operation of the present system in which the specialist maintains the user/specialist relationship by following up on the communication session with an additional communication as disclosed, for example, in the instant specification at page 13, lines 27-30. In the Ernie system, the FKP, not the specialist, performs this function as disclosed in Reference A, page 8, first column, second paragraph.

In light of the forgoing amendments and remarks, this application is now believed in condition for allowance and a notice of allowance is earnestly solicited. If the examiner has any further questions regarding this amendment, he is invited to call applicants' attorney at the number listed below. The examiner is hereby authorized to charge any fees or direct any payment under 37 C.F.R. §§1.17, 1.16 to Deposit Account number 02-3038.

Respectfully submitted



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